

REMARKS

The following issues are outstanding in the pending application:

- Claims 1-4, 6-16 and 21-23 are rejected under 35 USC 103.

Amendments to the Specification

The specification has been amended to include the new Figures 8a, 8b which describe the elements of paragraph [0012] relating to the peripheral retaining groove and engagement member on both the adjusting member and the tube portion. This text, with the associate reference numerals, has also been added to paragraph [0053]. Support for this material is found in paragraph [0012]. No new matter has been added.

Amendments to the Drawings

New drawings are being submitted to add Figures 8a, 8b that illustrate the features of the peripheral retaining groove and engagement member on both the adjusting member and the tube portion as described in paragraph [0012]. The number of drawing sheets is now 9 instead of 8. Replacement and annotated drawing sheets are being submitted with this response. Fig. 6 and paragraphs [0053] and [0063] already illustrate and describe one embodiment of the peripheral retaining groove on the tube portion. No new matter has been added.

Claim Amendments

Claims 1, 16 and 20 have been amended to more clearly define the subject invention. Amended claim 1 now recites an adjustable overflow for insertion into a tub-like container having a floor and a receiving aperture in which the adjustable overflow has a base with a discharge aperture, a cylindrical tube portion with an axial passageway which is attached to the base and communicates with the discharge aperture, and a tubular adjusting member. The adjusting member includes a peripheral retaining groove for co-operating with an engagement member on the tube portion or alternatively, the tube portion includes a peripheral retaining groove for co-operating with an engagement member on the adjusting

member. The cylindrical tube portion is configured to insert into the receiving aperture in the tub-like container such that the container floor adjacent to the receiving aperture is located between the top surface of the base and the adjustment member. Amended independent claims 16 and 20 include the same elements. Support for this amendment is found in Figs. 6, 8a and 8b, and paragraphs [0053] and [0063]. Claim 22 has been cancelled. No new matter has been added.

35 USC 103

Claims 1-4, 6-16 and 21-23 are rejected by the Examiner under 35 USC 103(a) as being unpatentable over U.S. Pat. No. 2,266,043 to Hutchins in view of U.S. Pat. No. 2,398,921 to Cook and further in view of U.S. Pat. No. 3,595,269 to Yeagle. Applicant respectfully traverses.

Hutchins describes a portable device that is adapted to be positioned over the drain opening for controlling the flow of liquid into the drain. The device comprises a base portion 1 and a hollow column 2 which is frictionally attached to the base member 1 in a fluid-tight relation. The base portion 1 comprises a tubular portion 5 and a skirt portion 6 formed integrally therewith. The tubular portion 5 snugly receives the lower end of the column 2 to seal with the latter and frictionally retain it in any position of rotation into which it may be turned. The material of the base 1 is extended inwardly at the lower end of the tubular portion 5, to provide a flange 8, which limits downward movement of the column 2 in the base portion to thereby facilitate the quick adjustment of the column in the base to bring the windows 3 and 7 at the same level. The skirt portion 6 of the base is of an over-all diameter sufficient to cover the usual strainer plate 12 in the drain opening of a sink so that it can lie thereover and seal with the bottom of the sink surrounding the strainer plate 12. See Fig. 2. This skirt-portion 6 is preferably made very thin and flexible so that it readily conforms to the sink in response to slight pressure of water or other liquid retained in the sink. The device is positioned immediately over the strainer plate 12 and concentric relative thereto so that the skirt 6 overlaps the strainer plate 12 on all sides and prevents leakage of water thereunder.

Cook describes an adjustable overflow for use in bathtubs to safely fill the level from three to five inches above what is normally permitted by the usual overflow outlets. The base

portion 10 of the overflow is secured over the conventional overflow outlet 12 on the side of a bathtub 14. See Fig. 2. A watertight joint must be provided where the base 10 contacts the surface of the tub 14. The overflow has a rotatable outside portion with openings that can be moved into and out of register with an interior wall with openings. Further openings are additionally provided on the top of the adjustable overflow to define a max level of fluid.

Yeagle is directed to a combined drain and overflow valve assembly adapted for upright mounting in the water reservoir of a humidifier. The drain/overflow valve assembly includes a hollow casing having a lateral inlet port and a hollow core rotatably mounted in the casing. The core has a longitudinal passage open at both upper and lower ends for overflow discharge. The humidifier has a tray bottom wall 27 with a noncircular aperture 28 through which the drain and overflow valve is placed such that a portion of the drain/overflow valve extends both above and below the tray bottom wall.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquires enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims, explained below. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. And finally, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741;

M.P.E.P. §2143. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

Applying the proper test to this case begins with amended independent claims 1, 16 and 20 that require an adjustable overflow for insertion into a tub-like container having a floor and a receiving aperture in which the adjustable overflow has a base with a discharge aperture, a cylindrical tube portion with an axial passageway which is attached to the base and communicates with the discharge aperture, and a tubular adjusting member, wherein the adjusting member includes a peripheral retaining groove for co-operating with an engagement member on the tube portion or alternatively, the tube portion includes a peripheral retaining groove for co-operating with an engagement member on the adjusting member. Hutchins does not disclose such a feature. The Hutchins device includes a base portion 1 and a hollow column 2 which is frictionally attached to the base member 1 in a fluid-tight relation. The base portion 1 comprises a tubular portion 5 and a skirt portion 6 formed integrally therewith. The material of base 1 is extended inwardly at the lower end of the tubular portion 5, to provide a flange 8, which limits downward movement of the column 2 in the base portion. Applicant respectfully submits that the flange 8 of Hutchins that extends inwardly at the lower end of the tubular portion 5 for limiting downward movement of the column 2 in the base portion is structurally different from both an adjusting member having a peripheral retaining groove for co-operating with an engagement member on the tube portion and the tube portion having a peripheral retaining groove for co-operating with an engagement member on the adjusting member as recited in amended independent claims 1, 16 and 20. There is also no similar structure disclosed in the Cook or Yeagle references.

In order to make a proper *prima facie* case for obviousness, all claim limitations must be accounted for. M.P.E.P. § 2143.03. This rejection fails to consider all elements of the claims and their meaning as the cited references do not include all elements of independent claims 1, 16 and 20. As discussed above, there is no teaching or suggestion in the Hutchins reference of an adjusting member having a peripheral retaining groove for co-operating with an engagement member on the tube portion, nor is there a tube portion having a peripheral retaining groove for co-operating with an engagement member on the adjusting member. Further, modifying the Hutchins reference with the teaching of Cook and Yeagle will not

result in the adjustable overflow of claims 1, 16 and 20. Thus, the claims are erroneously rejected over the cited references and Applicant respectfully requests the rejection be removed. Therefore, Applicant respectfully submits that amended independent claims 1, 16 and 20 are not obvious. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition non-obvious. Applicant respectfully submits that claims 2-4, 6-15, and 21-23 depend at least in part from amended independent claims 1, 16 and 20 respectively. Claim 22 has been cancelled. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1-4, 6-16 and 21-23 under 35 U.S.C. 103(a) as having subject matter unpatentable over U.S. Pat. No. 2,266,043 to Hutchins in view of U.S. Pat. No. 2,398,921 to Cook and further in view of U.S. Pat. No. 3,595,269 to Yeagle.

CONCLUSION

Applicant believe that no fees are due with this response. If any fees are due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03260US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

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REPLACEMENT SHEET